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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/960,668

09/21/2001

Yoram Ofek

SYN 1780

6833

20787

7590

04/21/2005

SITRICK & SITRICK

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SKOKIE, IL 60077

EXAMINER

PASCAL, LESLIE C

ART UNIT

PAPER NUMBER

2633

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8m

Office Action Summary	Application No.	Applicant(s)	
	09/960,668	OFEK ET AL.	
	Examiner	Art Unit	
	Leslie Pascal	2633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-65 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The reply filed on 10-42004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the applicant did not elect claims which read on specific species/subspecies. See paragraphs below. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species I) figure 1
- Species II) figure 6
- Species III) figure 7
- Species VI) figure 8
- Species V) figure 9
- Species VI) figure 11
- Species VII) figure 13
- Species VIII) figure 14
- Species IX) figure 21
- Species X) figure 28.

In addition to the above species, there are subspecies drawn to subsystems of the above species. These subspecies are drawn to the following subsystems:

Subspecies drawn to the alignment subsystem:

Subspecies A)	figure 4
Subspecies B)	figure 12
Subspecies C)	figure 27
Subspecies D)	figure 30
Subspecies E)	figure 31
Subspecies F)	figure 32

Subspecies drawn to the wavelength conversion subsystem:

Subspecies G)	figure 5A
Subspecies H)	figure 15A
Subspecies I)	figure 23A
Subspecies J)	figure 23B
Subspecies K)	figure 26A

Subspecies drawn to optical cross connect

Subspecies L)	figure 19B
Subspecies M)	figure 20

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. The applicant must elect ONE of the Species I-X. Then, depending on the species selected the applicant should elect EACH one of the corresponding subspecies that applies to the elected species. Applicant is reminded that only subspecies that have adequate disclosure in the specification may be selected. The applicant may only elect subspecies that are disclosed in the species. An example of a proper election would be, "I elect species VIII which corresponds to figure 14. I further elect the subspecies B drawn to figure 12, the subspecies D drawn to figure 15A and also subspecies M drawn to figure 20. The claims that read on this embodiment are...". Applicant is reminded that in order to be fully responsive, the applicant must elect one of

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each of the subspecies (alignment, wavelength conversion, crossconnect) *that applies* for **the elected** species.

4. In regard to the applicant's election, see the last sentence of paragraph 2 above (which is repeated from the last office action). It says, "in order to be fully responsive, the applicant **must** elect **one of each** of the subspecies (alignment, wavelength conversion, crossconnect) *that applies* for **the elected** species."

Although the applicant elected figure 14, he says that claims 1-65 read on this species. Clearly claims 3-21 do not read on figure 14 because the applicant uses the term "consisting of" which excludes other elements (the alignment subsystem and optical interconnection subsystem). See section 2111.03 of the MPEP which states: The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.") Claim 24 has similar problems (no optical interconnection subsystem). There are similar problems with numerous claims.

There appears to be a problem with several claims. For example claim 19, which "further comprises a plurality of alignment subsystems", is dependent on claim 3, which "consists of" a specific group of elements. See MPEP 2111.03, which says, "A claim which depends from a claim which "consists of" the recited elements or steps cannot add an element or step." There are similar problems with numerous claims (claim 22 etc).

Claim 41 claims "multiple wavelength conversion subsystems, which does not appear to be in figure 14. Clearly, claims 43-50 cannot in any way read on figure 14.

The claims that the applicant elects MUST read on the species elected.

The applicant argues that figures 1, 6-8, 11, 13 and 21 are illustrations of "the embodiment" of the presently claimed invention. These figures are mutually exclusive. For example, figure 1 is CLEARLY a separate embodiment from figure 14. An embodiment is a different arrangement of the same element. There is no structural equivalent of the star coupler and optical interconnect subsystem of figure 14 to figure 1. Nor is there a functional equivalent of the WDM DMUX of figure 1 (at the input) in figure 14. It is unclear what the applicant means by figure 1 illustrates the embodiment of figure 14.

Further, the applicant did not elect ONE of each of the SUBSPECIES as specified. To elect all of the subspecies is NON RESPONSIVE and WILL NOT BE ACCEPTED IN THE NEXT ACTION. This was spelled out CLEARLY in the previous office action in paragraph 3.

At this point, it appears that claims 1-2, 26-31 and 51 read on figure 14. The applicant then needs to elect between the cross connect (MUST elect between figures 19B and figure 20) and determine which claim(s) read on these figures. It does not appear, that as the claims read now (because of the term "comprising") that the applicant must elect between alignment and wavelength conversion subsystems because no claims which read on figure 14 at this point read on separate embodiments of the subsystems. If the applicant amends the claims to read on separate

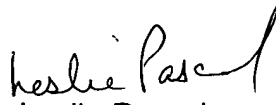
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embodiments of the alignment, wavelength conversion subsystems then the applicant WILL HAVE TO elect between subspecies. A subspecies is an ALTERNATE embodiment of the same element (i.e. a different figure showing how to provide wavelength conversion).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Pascal whose telephone number is 571-272-3032. The examiner can normally be reached on Monday, Friday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571-272-3022. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leslie Pascal
Primary Examiner
Art Unit 2633